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In the Supreme Court of the United States

No. 252

OCTOBER TERM, 1963.

HARRY A. TOULMIN, JR.,
Petitioner,

vs.

THE RIKE-KUMLER COMPANY and
MIAMI VALLEY NEWS AGENCY, INC.,
Respondents.

PETITION FOR A WRIT OF CERTIORARI
To the United States Court of Appeals
For the Sixth Circuit.

H. A. TOULMIN, JR.,
Petitioner,
Of the firm,
TOULMIN & TOULMIN,
11 South Wilkinson St.,
Dayton 2, Ohio.

THE GATES LEGAL PUBLISHING CO., CLEVELAND, OHIO—MAIN 1-5647

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For the Sixth Circuit.

Harry A. Toulmin, Jr., your petitioner, prays that a writ of certiorari issue to review the judgment of the United States Court of Appeals for the Sixth Circuit, entered in the above entitled case on April 17, 1963.

OPINIONS BELOW.

The opinions of the District Court and Court of Appeals are attached as Appendices A and B respectively.

JURISDICTION.

The judgment of the Court of Appeals was entered on April 17, 1963. The jurisdiction of this Court is invoked under the provision of 28 U. S. C. A. Para. 1254(1), (2), (3) and (6). (Set forth in Appendix C at page 14, *infra.*)

QUESTIONS PRESENTED.

1. Whether the deliberate copying of a part of a copyrighted book, for the purpose of lending an air of authenticity to the copier's book, constitutes an infringement of the copyright.

2. As to whether material copied from a copyrighted book, regardless of the amount, large or small, but admittedly of considerable importance in setting the background of the accused novel comes within the infringement provision of 17 U. S. C. A. Sec. 101 of the Copyright Law as set forth in Appendix D.

3. Does the doctrine of "fair usage" lend protection to a deliberate purloiner of copyrighted material who admittedly copied for the sole purpose of "lending an air of authenticity" to his own popular and fictional novel?

4. Whether, where there is a deliberate and intentional infringement of a valid and subsisting copyright and the owner of the infringed copyright is unable to prove actual damages, and the copyrighted book has been out of print for a number of years at the time of infringement, can the infringement be justified as being within the legal maxim "De minimis non curat lex"?

5. Is it necessary for a copyright owner, in order to prevail, to demonstrate actual damages as a result of the usurpment of his copyrighted material? Does not 17 U. S. C. A. 101(b) (set forth in Appendix D) provide for maximum statutory damages of $250.00 where no actual damage can be shown?

The above issues are of singular importance to copyright owners, also the public, and have not been settled by earlier decisions either by this Court or by the lower Courts. The decisions below have been based on the legal fictions of "de minimis" and "fair usage" which, to date,

have been subjected to various interpretations, leaving it entirely to the personal judgment of the Courts below as to the *amount* of material that must be copied to constitute infringement.

The Courts, even though attempting to be fair and impartial, have no yardstick or authoritative rules to go by to protect the copyright owner and at the same time to allow an accused party's use of his independently acquired information. The Courts rely solely upon their personal opinion which renders the copyright infringement law unpredictable, and in some cases, as meaningless.

The absolute effect of the copied material even when relatively small in quantity, on the prospective buyer of the book, and therefore the loss of sales and protection to the copyright owner, has seldom if ever, been duly considered by the Courts below, much less legally evaluated by them. The legal emphasis has been on *quantity*—not on *quality*, or *significance of the copied material*, which might affect the desirability for the book far more than the amount, however large, of the purloined material.

There have been few, if any, decisions of the high Court on the subject of copyright infringement, since the very old case of *Parris vs. Hexamer*, 99 U. S. 674 (1878) which seems to have been decided mainly on the basis of *quantity*, and *not* on the *commercial significance* of the material copied. In the present case, the importance of the copied material was actually admitted by the infringer, and even though small in quantity, it nevertheless was instrumental in giving an authoritative semi-historical background to the infringer's book as a whole.

We believe a final decision in this case initiated by this Request for Certiorari will assist in clarifying the rights of copyright owners against those who knowingly and cleverly usurp ideas expressed in the words of an-

other, even though the latter is of few word content but still serves to leaven the entire content of an accused book.

The Courts below held that the material taken from petitioner's book was both "fair use" and also, was a case of "de minimis." But these terms are *inconsistent* with one another, in that "fair use" does not presuppose that the matter was copied or adopted but only that the *underlying idea* was used. On the other hand, "de minimis" is based upon actual copying of the material, but that the amount is *too small* for the law to take notice. In the case in issue, the material copied was practically word for word of the copyrighted material so that the only issue should have been one of "de minimis,"—not of "fair use."

Your petitioner makes this point to show that the present case. if certiorari be granted, will allow this Court an opportunity to clarify, and give authoritative weight to the precise differences in the application of the "de minimis" and "fair use" theories for the guidance of the Courts below and the practitioners in those Court. Your petitioner would also have the opportunity to show that the *quantity* of material copied is only *one* of the basic factors that must be considered in the matter of copyright infringement, and the *qualitative content* of the copied material, in terms of setting the background of an infringing novel and other qualifying characteristic must also be considered. The latter may even predominate over any consideration of quantity of the copied material, great or small. The effect under the "de minimis" theory of the copied material on a novel or book as a whole, i.e. as to whether this material would permeate or carry through the book, even though small in actual quantity, must receive the attention of the legal tribunals in order to protect the rights of the copyright owner under the copyright infringement statutes.

STATUTES INVOLVED.

The statutes involved are the copyright laws of the United States, the pertinent portions of which are: 17 U. S. C. Para. 1 and 17 U. S. C. Para. 101. These sections are set forth in Appendix D at page 16, *infra*.

STATEMENT OF THE CASE.

Petitioner, in 1935, authored a book, called *With Pershing in Mexico*, which was in that same year copyrighted and published by The Military Service Publishing Company. The book underwent but one publication and was sold out within a year or two after being introduced on the market.

In 1958, a book called *They Came to Cordura*, written by Glendon Swarthout, was published by Random House Inc. in a hard cover edition and the following year the same book was published in a paperback edition by The New American Library of World Literature, Inc. The paperback edition was distributed in the Dayton, Ohio area by respondent, Miami Valley News Agency, Inc. Both the hard cover edition and the paper back edition were sold at retail to the public by respondent, The Rike-Kumler Company. These sales were made during the years 1958 and 1959.

In 1959, petitioner received an assignment of the copyright covering the book *With Pershing in Mexico*, which was duly recorded with the Copyright Office.

In February 1960 this action was initiated by petitioner against respondents in the Federal District Court in Dayton, Ohio, charging respondents with infringement of the subsisting copyright on the book *With Pershing in Mexico*.

In the beginning of Chapter Two, entitled "The Terrain," of petitioner's book, there is the following paragraph:

> *"If God had set out to mold a country as a stage for a cavalry campaign, he would have made* the plains, the streams, the ranches and mountains of Chihauhau —barren wastes, green oases, sterile sand, mud, magnificent mountains, mean adobe villages, fertile ranches and rich mines. All the grandeur of poverty, the misery of politics and the fury of Latin passions—that is Mexico. It was upon this enormous stage of the plains against the back drop of the Sierra Madre mountains that Pershing and Villa played their game of hide and seek. *This was a state five hundred miles long and a hundred miles wide across which snow, sandstorms, tropic heat and sharp cold added to the misery of the actors."*

In the foreword to the accused book, *They Came to Cordura*, sold by respondent, the italicized portions of the above quoted paragraph are set forth. In his testimony at the trial, the author of *Cordura*, Glendon Swarthout, admitted that he copied the passage in question from petitioner's copyright book, practically word for word, in order to lend an air of authenticity to the *Cordura* book. Without this air of authenticity, there is doubt as to whether *Cordura* would have sold in the quantities that it did, if at all. The Trial Court adopted this admission as one of its findings of fact.

Swarthout further testified, (a) a novel such as *Cordura* must have its stage upon which the story is presented, and that stage is set in the foreword; (b) the description of the terrain was the stage for the story in *Cordura*; (c) the passage taken from petitioner's book provided the backdrop for that stage.

In spite of these admissions by respondents' witness, the Trial Court held that the copying of that portion of petitioner's book was a "fair usage" thereof and that since the petitioner failed to show any actual damages as a result of the copying, the case was one of "de minimis." As we have pointed out, "fair usage" and "de minimis" are inconsistent with one another and not well understood by Courts or the practitioners therein, in the absence of authoritative direction by the high Court. The Trial Court entered judgment in favor of the respondents and against the petitioner on both of these grounds.

On appeal, the Court of Appeals affirmed the judgment of the Trial Court without additional reason or comment.

Respectfully submitted,

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APPENDIX A.

Findings and Judgment of the District Court.

(Civil Action No. 2442—Caption Omitted.)

(Filed June 30, 1962.)

1. Harry A. Toulmin, Jr., is the author of the book "With Pershing in Mexico," hereinafter referred to as "Pershing," published and copyrighted in 1935 by The Military Service Publishing Company of Harrisburg, Pennsylvania.

2. There was only a single printing of the "Pershing" book. The book has been out of print since 1936. There have never been any plans or intentions to republish or reprint the book.

3. The "Pershing" book is a factual account of the Punitive Expedition against Pancho Villa in the Mexican Province of Chihuahua in 1916 under the command of General John J. Pershing following a raid by Villa on the border town of Columbus, New Mexico. It is in no sense a novel.

4. The book alleged to infringe is "They Came to Cordura," hereinafter referred to as "Cordura," written by Dr. Glendon Swarthout of Scottsdale, Arizona. It was published by Random House of New York in a hard cover edition in 1958, and by The New American Library of World Literature of New York in a paper edition in 1959. These three parties are not residents of this District and were dismissed as parties defendant.

5. The paper back edition was distributed in the Dayton area by defendant, The Miami Valley News Agency, Inc. Both the hard cover edition and the paper back edition were sold at retail to the public by the defendant, The Rike-Kumler Company.

6. The total number of paper back copies of "Cordura" distributed by defendant, The Miami Valley News Agency, Inc., was less than 600 of which no more than 20 were sold by defendant, The Rike-Kumler Company. Less than 20 copies of the hard cover edition were sold by the Rike-Kumler Company. Defendants had no copies of the "Cordura" book on hand or for sale at the time of the trial, and had been out of such stock and had made no sales thereof for more than a year prior thereto. There were no plans by either company to sell or stock the book again.

7. No notice of infringement was given to either defendant, and the first knowledge The Rike-Kumler Company had of the claim was a newspaper story reporting the filing of this suit.

8. The "Cordura" book is a novel with a historical setting. Its Foreword states:

> "This is not a book about Villa. The characters, except for General Pershing and a newspaper correspondent who appears briefly, are imagined. The designations of military units have been altered. It is a book about certain minor fictitious events before and after the lost, last charge at Ojos Azules, which means Blue Eyes."

Its time and setting are those of the last cavalry charge of the Mexican campaign and, starting from that point, it is the story of an imaginary trip made by a fictitious group of prisoners including a woman through difficult and barren country on a perilous journey back to civilization. The description of the cavalry engagement is based on fact and the description of the terrain through which the journey was made is also factual, the outgrowth of a trip made to the area by Swarthout for the purpose of becoming acquainted with the territory preparatory to writing

about it. In all other respects, the characters, the story and the action are fictitious.

9. In the Foreword to "Cordura," there is a quotation consisting of a portion of the first sentence and the last sentence of one paragraph found in the "Pershing" book. The "Pershing" book contains 10 chapters, 142 pages in all, Chapter 2 containing the quoted portion. This chapter comprises 8 and ½ printed pages of which the quoted sentences occupy about a seventh of one page.

10. The charge of alleged infringement is based on the following passage appearing in the Foreword of "Cordura":

> "Of the terrain, one officer, writing twenty years later, concluded that 'If God had set out to mold a country as a stage for a cavalry campaign, he would have made * * * Chihuahua * * *. This was a stage five hundred miles long and a hundred miles wide across which snow, sandstorms, tropic heat and sharp cold added to the misery of the actors."

11. Glendon Swarthout had served on an awards commission while with the U. S. Army in Italy in World War II. He was seeking a basis for writing a story involving that experience and happened to come across an account of the Mexican Campaign under Pershing against Pancho Villa.

12. In researching in the library at the Michigan State University, where he was then teaching, to find source materials to use as a background for "Cordura," Swarthout found only two books that had ever been written on the Mexican Punitive Expedition. One was a comprehensive and authoritative source by a cavalry officer who had personally taken part in the campaign, namely, "Chasing Villa" by Colonel Frank Tompkins, copyrighted 1934 by The Military Service Publishing Company of

Harrisburg, Pennsylvania. The other was the "Pershing" or Toulmin book.

13. In studying background material, Swarthout made liberal use of Tompkin's book and the "Cavalry Journal," published by The American Cavalry Association. He found contemporary issues of that Journal especially valuable because they contained detailed reports from officers who were then taking part in the campaign.

14. Swarthout used quoted material from both the Tompkins book and the "Cavalry Journal" and from other sources, the quotes varying in length from a few words to a paragraph or more.

15. Swarthout also read the Toulmin book while he was writing "Cordura." He considered it a secondary source because Toulmin had not personally been present or taken part in the campaign.

16. Swarthout selected these two sentences and quoted them, stating that "one officer, writing twenty years later, concluded that * * *" in order to lend an air of authenticity to his book.

17. In the "Pershing" book, Toulmin followed the same pattern as Swarthout as to quoting from an unidentified cavalry officer. At page 47, he used a quotation from an officer identified only by the phrase "as one officer expressed it * * *."

18. The use of one sentence and a part of another by Swarthout in "Cordura" taken from "Pershing," represents neither a substantial nor material part of the latter, was insignificant in value and extent of the copyrighted material, did not in any degree prejudice the sale, diminish the profits or supersede the objects of the original work, and was thus a "fair use" thereof.

19. The sentences used had no effect whatsoever on the acceptance or sale of the "Cordura" book. Toulmin was not, and could not have been, damaged in any way by the publication of "Cordura."

20. The sentences used in "Cordura" are not the heart and core of the entire theme of the Toulmin book; they do not in fact relate to that theme at all.

21. The clear facts and the only possible inferences than can reasonably be drawn from them establish beyond possibility that this case is a clear case of de minimis.

22. Since the "Pershing" book had been out of print for at least 22 years before "Cordura" was published, there was not and could not have been any unfair competition or unfair trade practice with plaintiff as alleged in the Complaint.

JUDGMENT.

Judgment is therefore entered in favor of the defendants and against the plaintiff herein and costs are assessed against the plaintiff. The matter of assessment of reasonable atttorney fees as prayed for in the complaint is continued until further order of the Court.

/s/ WEINMAN, J.,
Chief Judge U. S. District Court.

Journal entry not required.

APPENDIX B.

Order of the United States Court of Appeals for the Sixth Circuit.

(Filed April 17, 1963.)

(Caption Omitted.)

BEFORE: MILLER and O'SULLIVAN, Circuit Judges, and McALLISTER, Senior Circuit Judge.

In this action charging the defendants with violation of the plaintiff's copyright, in that the defendants published a book by a different author which contained a deliberate copy of a sentence and a half from plaintiff's copyrighted book of 142 pages which has been out of print since 1936, with no plans or intentions at any time to republish or reprint the book, the District Judge was of the opinion, among other things, that this was a clear case of de minimis and entered judgment for the defendants.

IT IS ORDERED that the judgment be affirmed with costs assessed against the appellant.

Approved for entry:

/s/ SHACKELFORD MILLER, JR.,

United States Circuit Judge

APPENDIX C.

(Referred to on page 1 of the Petition.)

Title 28 U. S. C. A. Para. 1254(1) reads:

"Prior Law—Except as was provided in Act Mar. 3, 1891, ch. 517, Para. 6, 26 Stat. 828, certiorari could not be made to serve the purpose of an appeal or writ of error. * * *"

Title 28 U. S. C. A. Para. 1254(2):

"Purpose—'In order to guard against any injurious results which might flow from having nine appellate courts, acting independently of each other, power was given to this court to bring before it for decisions by those courts. In that way it was believed that uniformity of ruling might be secured, as well as the disposition of cases whose gravity and importance rendered the action of the tribunal of last resort peculiarly desirable.' Warner v. New Orleans, 1897, 17 S. Ct. 892, 167 U. S. 467, 42 L. Ed. 239.

"Prior to 1925 the jurisdiction conferred on the Supreme Court to review decrees of the Circuit Court of Appeals on certiorari was not conferred merely to give the defeated party another hearing, but to secure uniformity of decision and to bring up cases of importance, which it is in the public interest to have decided by the court of last resort. Magnum Import Co. v. Coty, N. Y. 1923, 43 S. Ct. 531, 262 U. S. 159, 67 L. Ed. 922. See, also, Columbus Watch Co. v. Robbins, Ohio 1893, 13 S. Ct. 594, 148 U. S. 266, 37 L. Ed. 445."

Title 28 U. S. C. A. Para. 1254(3):

"Amendment of 1925—The great purpose of the 1925 amendment to former section 347 of this title was to curtail the Supreme Court's obligatory jurisdiction by substituting, for the appeal as of right, discretionary review by

certiorari in many classes of cases. Ex parte Republic of Peru, La. 1943, 63 S. Ct. 793, 318 U. S. 578, 87 L. Ed. 1014."

Title 28 U. S. C. A. Para. 1254(6):

"To whom application made—Application for writ of certiorari must be made to Supreme Court, but application for stay should be made in first instance to Circuit Court of Appeals. Nelson v. Lewis, D. C. N. Y. 1935, 9 F. Supp. 406.

"Application for certiorari must be made to the court while in session. The Conqueror, N. Y. 1897, 17 S. Ct. 510, 166 U. S. 110, 41 L. Ed. 937."

APPENDIX D.

Title 17 U. S. C. A. Para. 1 reads:

"Exclusive rights as to copyrighted works—Any person entitled thereto, upon complying with the provisions of this title, shall have the exclusive right:

(a) To print, reprint, publish, copy, and vend the copyrighted work;"

Title 17 U. S. C. A. Sec. 101 reads:

"Infringement—If any person shall infringe the copyright in any work protected under the copyright laws of the United States such person shall be liable:

(a) Injunction.—To an injunction restraining such infringement;

(b) Damages and profits; amount; other remedies.—To pay to the copyright proprietor such damages as the copyright proprietor may have suffered due to the infringement, as well as all the profits which the infringer shall have made from such infringement, and in proving profits the plaintiff shall be required to prove sales only, and the defendant shall be required to prove every element of cost which he claims or in lieu of actual damages and profits, such damages as to the court shall appear to be just, and in assessing such damages the court may, in its discretion allow the amounts as hereinafter stated, but in case of a newspaper reproduction of a copyrighted photograph, such damages shall not exceed the sum of $200 nor be less than the sum of $50, and in the case of the infringement of an undramatized or nondramatic work by means of motion pictures, where the infringer shall show that he was not aware that he was infringing, and that such infringement could not have been reasonably foreseen, such damages shall not exceed the sum of $100; and in the case of an

infringement of a copyrighted dramatic or dramatico-musical work by a maker of motion pictures and his agencies for distribution thereof to exhibitors, where such infringer shows that he was not aware that he was infringing a copyrighted work, and that such infringements could not reasonably have been foreseen, the entire sum of such infringing motion picture shall not exceed the sum of $5,000 nor be less than $250, and such damages shall in no other case exceed the sum of $5,000 nor be less than the sum of $250, and shall not be regarded as a penalty. But the foregoing exceptions shall not deprive the copyright proprietor of any other remedy given him under this law, nor shall the limitations as to the amount of recovery apply to infringements occurring after the actual notice to a defendant, either by service of process in a suit or other written notice served upon him."